

### REMARKS/ARGUMENTS

Reconsideration of the above-identified application in view of the present amendment is respectfully requested.

The present application has been amended to clarify the patentable features of the Applicant's invention and to overcome the rejections issued by the Examiner. In particular, claims 1 and 15 have been amended. Claims 1-5, 7, 8 11-14 and 18-28 stand withdrawn. Reconsideration of the rejection of this application is hereby requested.

Claims 6, 9, 10 and 15-17 were rejected under 35 U.S.C. §112 based on the language "said intermediate port" forming part of claim 6. It is believed that the amendatory language added to claim 6 obviates this rejection.

Claims 6, 15 and 17 were rejected under 35 U.S.C. §102(b) as being anticipated by Gold. Anticipation requires a single prior art reference that discloses each element of the claim. W.L. Gore & Associates v. Garlock, Inc., 220 U.S.P.Q. 303, 313 (Fed. Cir. 1983), cert. denied 469 U.S. 851 (1984). Additionally, the single prior art reference must disclose each and every element of the claimed invention, arranged as in the claim. Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984). "There must be no difference between the claimed invention and the reference disclosure, as viewed by a person

of ordinary skill in the field of the invention". Scripps Clinic & Research Foundation v. Genentech Inc., 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991). "The identical invention must be shown in as complete detail as is contained in the ... claim". Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Claim 6, as well as its related dependent claims 15 and 17 are not anticipated by the Gold reference. In particular, Gold does not teach a bypass/diverter valve having, among other features, a cylindrical sidewall forming part of a valve chamber with an opening that partially defines a fluid flow path. The flow path communicates a spool region in the spool with a transfer chamber located adjacent the valve chamber. The flow path includes the openings in the disk-like member and the wall opening in the cylindrical wall. In Gold, the fluid appears to flow from one opening 32 in the upper disk 29 to another opening 32 in the upper disk 29. The fluid path in Gold is not from the opening 32 to a wall opening in a cylindrical wall and into an adjacent transfer chamber. Moreover, there is no suggestion for such a construction in the Gold reference. Accordingly, claim 6, and its associated dependent claims, should be allowed.

Claims 6 and 16 were also rejected under 35 U.S.C. §102(b) as being anticipated by Bergman. These claims are not anticipated by Bergman for reasons similar to those that are discussed above. Bergman clearly does not show a

structure that defines a flow path from a spool region to a transfer chamber located adjacent the valve chamber. Bergman does not even disclose or suggest a transfer chamber. There is not even a remote suggestion to include such a construction in the Bergman valve. Accordingly, claim 6 should be allowed. Claims 9, 10 and 15-17, which depend from claim 6, are also allowable over the art of record or known to the Applicant.

In view of the foregoing amendment and discussion, it is respectfully submitted that the claims in the application are now patentably distinct from the prior art, each from the other, and this application is in condition for allowance. Prompt notice to that effect is respectfully requested.

Please charge any deficiency or credit any overpayment in the fees for this response to our Deposit Account No. 20-0090.

Respectfully submitted,

/John R. Hlavka/

John R. Hlavka

Reg. No. 29,076

TAROLLI, SUNDHEIM, COVELL,  
& TUMMINO LLP

**CUSTOMER NO.:26294**

Phone:(216) 621-2234

Fax: (216) 621-4072